

Remarks

Reconsideration and allowance of this application are respectfully requested.

New Grounds of Rejection Not Proper for Final Office Action

First, pursuant to 37 CFR 1.193 (a) (2) introduction of a new grounds or rejection is not proper for a final office action. As noted by the examiner on Page 4 of the Office Action the grounds for the final office action are the introduction of a new grounds. The examiner properly notes that an exception applies where the applicant has caused the introduction of the new grounds based on a revised claim. However, in this case it can be seen that the revised claim was required substantially because the initial office action had incorrectly stated that Hailey had defined an absorbent “synthetic felt”, which the examiner acknowledges in the final office action Hailey did not. As such, the revised claims and response to the initial office action sought to clarify this point.

As such, the applicant respectfully requests as a first consideration, that the office action be withdrawn as a final office action. In addition, as shown below the lack of mootness given consideration of the arguments below for claims 1, 2, 5 and 8 should be further reconsidered.

Absent reconsideration of the office action as being final are the following in response to the specific merits of the office action of January 9, 2005.

Rejection Under USC §103 (a) Claims 1 and 2; Hailey in light of Demott

Under USC §103 (a), the prima facie case of obviousness must first be established. Which requires that (1) one or more references, (2) available to the inventor, (3) which teach, (4) a suggestion to combine or modify the references, (5) the combination of modification of which would appear to be obvious to one of ordinary skill in the art...

The office action, notes that Demott discloses a material which may be used in conjunction with a coaster. (Page 3 Office Action). As noted in Ex parte Obukowicz (27 USPQ2d) the fact that prior art gives an invitation to explore, is not enough to teach for the combination. This is the case here, the mere suggestion that a synthetic felt used in a completely different design may be used in coasters does not teach the inventors design. The specific combination of layers used by Beard in this application with the dual sided adhesive layer is nowhere hinted at, nor is any means suggested as to how such a material may be incorporated into a coaster design.

35 USC §103 (a) over Hailey in view of Demott

As noted above the same prima facie case must be made here for Demott; first given the failure of the argument above this combination would therefore not be a grounds of rejection. However, beyond and above that argument, the applicant respectfully suggests that a factual oversight undercuts this rejection. One page 3 last paragraph, of the office action, it is stated that “the thread would have to be slightly raised above the layer”, in order to view in from the top”. This is not in fact the case, for Dauer, which suggests that the coaster body is a soft cloth “such as cotton” which is used to wrap around stemware. In this regard, when the stitching is sewn into the coaster body, the thread will tend to depress into the “coaster body” therefore not raising it above the surface of the “coaster body”. There is no drawing or description in Dauer which suggest that raising the stitching above the top surface of the coaster body occurs or is in any way desirable. Beard, on the other hand, uses an overlaid stitching in a synthetic felt with the specific goal of raising the embroidered design above the top surface of the coaster absorbent material. The still nature of the “synthetic felt” as compared to cotton for example allows for this raised surface. This combination is in no way suggested in Dauer.

In response, given the arguments above with the claims as amended allowance of this application is requested.

List of Claims

1. Claim 1 (previously amended)

A coaster comprising,

a. main body with a top surface, a bottom surface and an outer edge,

b. and an absorbent layer with a top surface and bottom surface,

c. and an adhesive layer with a top surface and bottom surface,

where the bottom surface of said absorbent layer is affixed to the top surface of said adhesive layer, where the bottom surface of said adhesive layer is affixed to the top surface of said main body, where said top surface of said adhesive layer has a stronger adhesive bond with said bottom surface of said absorbent layer as compared to the adhesive bond between said bottom surface of said adhesive layer and said top surface of said main body, where this difference in bonds allows for removal of said absorbent layer from said main body with said adhesive layer remaining attached to said absorbent layer,

d. where said absorbent layer is synthetic felt.

2. Claim 2 (previously amended)

a. main body with a top surface, a bottom surface and an outer edge,

b. and an absorbent layer with a top surface and bottom surface,

c. and an adhesive layer with a top surface and bottom surface,

where the bottom surface of said absorbent layer is affixed to the top surface of said adhesive layer, where the bottom surface of said adhesive layer is affixed to the top surface of said main body, where said top surface of said adhesive layer has a stronger adhesive bond with said bottom surface of said absorbent layer as compared to the adhesive bond between said bottom surface of said adhesive layer and said top surface of said main body, where this difference in bonds allows for removal of said absorbent layer from said main body with said adhesive layer remaining attached to said absorbent layer, where said absorbent layer is synthetic felt

d. and a seating ring where said seating ring is attached to the top surface of said main body, where the point of attachment is along said outer edge of said main body,

e. and a support ring where said support ring is attached to the bottom surface of said main body, where the point of attachment is very near the outer edge of said main body.

Claims 3 and 4 (previously canceled)

Claim 5 (canceled)

Claims 6 and 7 (previously canceled)

Claim 8 (canceled)

Claim 9 (added)

The coaster of claim 1, further comprising an embroidered pattern, said embroidered pattern comprised of thread which is woven into said absorbent layer, so that said embroidered pattern is raised above said top surface of said absorbent layer, where said pattern is raised at least one diameter of said thread above said top surface of said absorbent layer.

Claim 10 (added)

The coaster of claim 2, further comprising an embroidered pattern, said embroidered pattern comprised of thread which is woven into said absorbent layer, so that said embroidered pattern is raised above said top surface of said absorbent layer, where said pattern is raised at least one diameter of said thread above said top surface of said absorbent layer.